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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,782

03/25/2004

Tsai-Ming Lo

10832-US-PA

2781

31561

7590

02/22/2006

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE

7 FLOOR-1, NO. 100

ROOSEVELT ROAD, SECTION 2

TAIPEI, 100

TAIWAN

EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,782	LO, TSAI-MING	
	Examiner	Art Unit	
	Christopher Bottorff	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Species I, Figures 5A-5C and 6A, in the reply filed on January 26, 2006 is acknowledged. Because applicant did not distinctly and specifically point out errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The amendment filed with the election has been entered. Claims 13-15 are canceled. Claims 1-12 and 16-18 are pending and have been considered as being directed toward the elected species.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The term "of" should be inserted between "pair" and "universal" in line 1 to make the abstract clearer.

Also, the title of the invention is presented in brackets "[...]" that suggest that this is not the true title of the invention but a proposed title. The brackets surrounding the title should be deleted for clarity.

Claim Objections

Claims 4-6, 10, 11, and 16 are objected to because of the following informalities:

Claim 1 a pair of first side plates and a pair of second side plates, which indicates that there are a plural number of plates. However, each of claims 4-6, 10, and 11 refer to a singular plate rather than the plural plates that exist in the pair. As a result, the claims are not clear as to which of the plural plates is defined in each of claims 4-6, 10, and 11. For the purposes of examination, the claims have been interpreted to define each respective plate of the pair such that plural plates are defined throughout the claims.

Claim 16 requires the fasteners to be both rivets and screws. However, paragraph 0029, lines 16-21, of the specification suggests that these fasteners may be used as alternatives (rivets or screws) rather than being used together. For the purposes of examination, claim 16 has been interpreted such that rivets or screws may be used.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in

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the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 defines "length-adjusting members" in lines 11-13. However, the disclosure indicates the members are merely plates fixed to the front and rear bases without any inherent length adjustment mechanism in any one plate. The invention does not include a mechanism by which length can be adjusted anywhere in the system (for example, the front and rear bases are not disclosed as being longitudinally adjustable). The claims have been interpreted as defining a pair of replaceable members, without any length-adjusting characteristic.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the rear section" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the wheel axle hole" in line 5. There is insufficient antecedent basis for this limitation in the claim. Inserting the term "hole" after "an wheel axle" in line 4 would provide proper antecedent basis.

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Claim 8 recites the limitation "each first plate" in line 2. There is insufficient antecedent basis for this limitation in the claim. Inserting "side" between "first" and "plate" would provide proper antecedent basis.

Claim 18 recites the limitation "the extension wheel assembly" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. Amending claim 18 to depend from claim 2 would provide proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin US 5,533,740.

Lin discloses a universal in-line skating shoe comprising a front base 20 and a rear base 30. See Figures 1 and 3. The front base 20 has a pair of first side plates 22 and a sole plate 21, wherein the first side plates 22 are connected to the sole plate 21 and each side plate 22 has at least a wheel axle hole 220. See Figure 1. The rear base 30 has a pair of second side plates 32 and a heel plate 31, wherein the second side plates 32 are connected to the heel plate 31 and each second side plate 32 has at least a wheel axle hole 320. See Figure 1. A shoe body has a front section fastened to the sole plate 21 and a rear section fastened to the heel plate 31. See column 2, lines

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11-18. A plurality of wheel assemblies 50 is mounted on the front base 20 and the rear base 30 through the wheel axle holes 220 and 320. See Figures 1 and 3. A pair of replaceable members 11 is provided, wherein one end of each member 11 is connected to a first side plate 22 while the other end of the member is connected to a second side plate 32. See Figures 1 and 3.

Each replaceable member 11 further comprises a front connecting section at the front portion of member 11, a rear connecting section at the rear portion of member 11, and a length extension section at the central section of member 11. See Figure 1. The front connecting section and the rear connecting section are linked through the length extension section, the front connecting section is connected to the first side plates 22 of the front base 20, and the rear connecting section is connected to the second side plates 32 of the rear base 30. See Figure 3. The front connecting section of each replaceable member 11 and the rear end of the corresponding first side plate 22 have a plurality of screw holes 12 and 22 respectively, such that the front connecting section and the first side plate can be connected using screws 51. See Figure 3. The rear connecting section of each replaceable member 11 and the front end of the corresponding second side plate 32 have a plurality of screw holes 12 and 320 respectively, such that the rear connecting section and the second side plate 32 can be connected using screws 51. See Figures 1 and 3. Also, each replaceable member 11 comprises a plate with a rectangular cross-section. See Figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin US 5,533,740 in view of Sanabria US 5,642,894.

Lin does not disclose a pair of wheel extension plates with a wheel extension assembly. However, Sanabria teaches the desirability of providing a skate with a pair of wheel extension plates 38, 40. See Figure 3. The wheel extension plates of Sanabria are fastened to the front end of first side plates 19 and have an extension wheel assembly 26 mounted on a wheel axle hole of the wheel extension plates 38, 40. See Figure 7. Each wheel extension plate 38, 40 has a screw hole 48, 50 and the front end of each first side plate 19 has a screw hole (accommodating bolt 20d in Figure 1) such that the wheel extension plate and the front end of the side plate can be joined together using a screw 54. See column 4, lines 6-19.

From the teachings of Sanabria, providing the skate of Lin with wheel extension plates and wheel extension assemblies would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enhance the performance of the skate. Also, providing a plurality of screw holes with a plurality of screws on the wheel extension plates and first side plates represents an obvious duplication of part that would increase the reliability and strength of the connection.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin US 5,533,740 in view of Chen US Des. 377,959.

Lin does not disclose the claimed brake assembly. However, Chen teaches that providing a brake assembly on a skate is desirable. See Figure 1. The brake assembly of Chen comprises a braking base and a braking head fastened to the braking base, with the braking base having two side surfaces that are fastened to the front end of first side plates of a front base and with the braking head being capable of being dismantled from the braking base or replaced while the shoe body is still fastened to the front base. See Figure 1. The two side surfaces of the braking base further comprise at least a screw hole and each first side plate of the front base has a corresponding screw hole such that the braking base can be fastened to the front base through screws. See Figure 1.

From the teachings of Chen, providing a brake assembly of the type defined in claims 7 and 8 on the skate of Lin would have been obvious to one of ordinary skill in the art at the time the invention was made. This would assist a skater in stopping the skate when desired.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin US 5,533,740 in view of Salatino US 6,773,131.

Although Lin discloses that the shoe body is fastened to the sole plate and heel plate at holes 210 and 310 respectively, Lin does not disclose that rivets or screws are

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the fasteners used. However, Salatino teaches the desirability of fastening a skate shoe body to a base with rivets or screws. See column 2, lines 5-10. From the teachings of Salatino, using rivets or screws to fasten the shoe body of Lin to the sole plate and heel plate would have been obvious to one of ordinary skill in the art at the time the invention was made. This would utilize fasteners that are effective in joining skate members and are widely available.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin US 5,533,740 in view of Lew US 5,503,466.

Although each wheel assembly of Lin includes a wheel 50 and a wheel axle 51 with the wheel 50 supported by the wheel axle 51, Lin does not disclose a bearing positioned within the central portion of the wheel. However, Lew teaches the desirability of positioning a bearing 99 within the central portion of a wheel. See column 12, lines 21-32. From the teachings of Lew, positioning a bearing in the central portion of the wheel would have been obvious to one of ordinary skill in the art at the time the invention was made. This would help facilitate efficient rolling of the wheel.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin US 5,533,740 in view of Sanabria US 5,642,894 as applied to claim 2 above, and further in view of Lew US 5,503,466.

Although the wheel extension assembly resulting from the combination of Lin and Sanabria includes a wheel and a wheel axle with the wheel supported by the wheel axle

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(see Figures 2 and 3 of Sanabria), Lin and Sanabria do not disclose a bearing positioned within the central portion of the wheel. However, Lew teaches the desirability of positioning a bearing 99 within the central portion of a wheel. See column 12, lines 21-32. From the teachings of Lew, positioning a bearing in the central portion of the wheel would have been obvious to one of ordinary skill in the art at the time the invention was made. This would help facilitate efficient rolling of the wheel.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshimoto, Yu, Conte, Chen, Borel et al., Caeran et al., Goodman, Lenoir, and Chou disclose skate arrangements. Martin teaches a wheel assembly with a bearing. Goldsmith et al. teach fastening the sole and heel plates of a skate with rivets and screws.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Christopher Bottorff", written in a cursive style.

Christopher Bottorff